

# Notice of Allowability

Application No.

09/636,497

Examiner

Marc S. Zimmer

Applicant(s)

WANG, YI-FENG

Art Unit

1712

dd

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to interview on 12/04/03.
2. ☒ The allowed claim(s) is/are 6-10, 14-18 and 21-24.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

- |  |   |
|--|---|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)          |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. _____. |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____  | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                  |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance            |
|  | 9 <input type="checkbox"/> Other  |

### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Kenneth Wheelock on December 4, 2003.

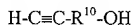
The application has been amended as follows:

In the Specification at page 6, line 7, please replace the phrase "in the acetylenic position" with

--  $\alpha$  to the acetylene group --

In claim 6, please replace the period at the end of the claim with,

-- and wherein the low compression set additive is an acetylene alcohol having the formula:



wherein  $\text{R}^{10}$  is a divalent hydrocarbon radical comprising 6 to 40 carbon atoms where the structure of  $\text{R}^{10}$  may be any combination of linear, branched, aliphatic, aromatic, and olefinic, with the limitation that the alcohol is always  $\alpha$  to the acetylene group. --

Also in claim 6, please remove the phrase, "an effective amount of" from the description of component (g).

Please add new claim 24:

24. The composition of claim 6 wherein the low compression set additive is 1-ethynyl-1-cyclohexanol.

In an interview with Applicant on the aforementioned date, the Examiner requested that they consider specifying the genus of compounds employed as the compression set additive to avoid a reference disclosing a similar invention that was commonly assigned (Burkus et al., U.S. patent # 5,998,516). After thorough discussion of the merits of *Burkus*, Applicant indicated their willingness to add the claim limitations of original claim 19 to claim 6.

As for the removal of the phrase "an effective amount of" preceding the mention of the low compression set additive, Applicant was advised that while the highlighted phrase in their response defined the role of component (g), there was not, in fact, any direction as to what constituted an effective <sup>amount</sup> insofar as Applicant does not expressly state to what extent the compression set should be lowered. It was, therefore, suggested that Applicant merely removed this language from the claim.

#### ***Allowable Subject Matter***

Based on an indication of allowable subject matter in claim 6, Applicant has cancelled claim 1 and added all of the limitations recited therein to amended claim 6 effectively rendering moot the other rejections over *Conway* and *Jensen*. However, in an updated survey of the prior art, the Examiner discovered Burkus et al., U.S. patent # 5,998,516. Burkus discloses a silicone molding composition comprising (A) an alkenyl-terminated polydiorganosiloxane having a viscosity in the range of 2000-1,000,000 cp, (B) a filler of which precipitated silica is preferred, (C) a platinum catalyst, (D) an organohydrogenpolysiloxane, and (E) a hydroxyl group-terminated organopolysiloxane, in addition to a cationic nitrogen compound that functions as a low compression

additive. Because (i) components (a) and (b) of Applicant's amended claim 6 are overlapping in scope and, hence, may be anticipated by a single ingredient in a reference and (ii) the upper extreme of the viscosity range for (A) and the lower extreme of the claimed viscosity range for (a) coincide, Burkus would have completely anticipated, or at least rendered obvious, claim 6 and many of the claims dependent therefrom.

In view of the discovery of *Burkus et al.* and the fact that it is commonly assigned, an interview was initiated by the Examiner to determine whether Applicant wished to identify an approach for obviating the impending rejection. After some discussion, Applicant requested that the Examiner incorporate by way of Examiner's amendment the limitations of original claim 19 into claim 6 thereby overcoming any potential rejection over the *Burkus*. In the Examiner's opinion, presently amended claim 6, the base claim, is not anticipated or rendered obvious by this reference because there is nothing motivating one of ordinary skill to replace the nitrogen-based low compression set additive described by the reference with an acetylenic alcohol. For at least this reason, claims 6-10, 14-18, and 21-24 are allowable.


Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

December 4, 2003

  
MARGARET G. MOORE  
PRIMARY PATENT EXAMINER  
ART UNIT 1712